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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/556,839	04/21/2000	Miriam Mawle	06181-862002	6339

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EXAMINER

WHITE, CARMEN D

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/556,839

Applicant(s)

MAWLE ET AL.

Examiner

Carmen D. White

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5 and 7-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Sharpe** III et al in view of **Gabai** et al.

Regarding claims 1-3, 5 and 7-40, Sharpe teaches a game comprising a toy figure that includes memory for storing information relating to the toy figure; a first game system [*local computer- see Fig. 4*] configured to communicate with the toy figure, download the stored information relating to the toy figure, receive input from a user, and alter the stored information based on the received input and the downloaded information; and a second game system [*remote computer- see Fig. 4, #92*] configured to communicate with the toy figure, download the stored information relating to the toy figure, receive input from a user, and alter the stored information based on the received input and the downloaded information (abstract; col. 1, lines 45-57; col. 2, lines 29-32; col. 2, lines 43-45 and lines 67 through col. 3, lines 1-8). Sharpe teaches that various different types of game systems can be used for communicating and downloading stored information to the toy figure (see col. 2, lines 14-32). Sharpe further teaches that the *behavior* {i.e. play pattern} of the toy figure is *uniquely modified each time the toy is removed from the data source* {i.e. game system}. Sharpe is silent regarding the

explicit teaching of the first game system including a first design that provides a first play pattern with a representation of the toy figure and the second game system including a second design that provides a second play pattern with a representation of the toy figure that is different from the first play pattern. While Sharpe teaches the incorporation of the a play pattern associated with the toy figure, Sharpe does not provide the clearest details of the play pattern associated with the figure. In an analogous toy figure gaming system, Gabai provides a clearer teaching of a toy figure that is used in correspondence with a computer gaming system to provide a play pattern (game) with the toy figure as a character in the game (Fig. 2A, #160; Figure 1A, #105, #110, #122, #130; col. 3, lines 41-50; col. 9, lines 10-21). It would have been obvious to a person of ordinary skill in the art to enhance the toy figure of Sharpe to include the figure in a game on the display, as taught by Gabai, in order to make the game more exciting for the user of the toy; whereby the user feels like she or he has more control over the outcome of the game. Further, it would have been obvious to a person of ordinary skill in the art at the time of the invention to update the feature of Sharpe that allows different features to be downloaded to the figure so as to change operation of the figure, to further include a different play pattern (i.e. game) from each type of game system in order to make the game more interesting and different each time. Sharpe has the functional capability of providing this function. For instance if the first game system (the local computer) has been used to download all the available game features stored thereon, then the user can go to the second game system (the remote computer) to download game features that are not currently stored on the local computer.

Claims 4 and 6 rejected under 35 U.S.C. 103(a) as being unpatentable over **Sharpe III** et al in view of **Gabai** et al, further in view of **Kikinis**.

Regarding claims 4 and 6, Gabai and Sharpe teach all the limitations of the claims as discussed above. While Gabai teaches modes of wireless communication between the game systems and the toy figures, Gabai is silent on the use of mating connectors and inductive or capacitive coupling as communications modes. In analogous gaming system, Kikinis teaches the use of a plurality of communication modes including the aforementioned modes (col. 3, lines 6-12). The examiner takes official notice that it is well known in the art to use these modes for communication between electronic devices. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to employ the use of these modes, as taught by Kikinis, in Sharpe and Gabai in order to provide reliable, efficient modes of transferring data between the game systems and the toy figures.

***Pertinent Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Goto et al teach a portable electronic gaming device that can be connected to other devices or a master game device for download of game data and storage in the memory of the portable gaming device. Yokoi ('871) and Yokoi ('966) teach portable electronic toys that simulate the growth of the creature that the toy represents.

***Examiner's Response to Applicant's Remarks***

The amendment to the claims provides additional clarification to the instant claim language. This has resulted in the examiner utilizing previously cited references in the above claim rejections. However, the examiner has slightly altered the combination of the references. The examiner has considered the newly amended claims in light of the instant disclosure and concluded that the limitations of the claims are still taught by the Sharpe, Gabai and Kikinis patents.

Applicant argues that the Sharpe and Gabai references do not teach the features of the independent claims 1 and 34 of "providing a play pattern or performing a play pattern procedure with a representation of a toy when a game system communicates with the toy". The examiner disagrees and has cited, above, where these features are taught in both Sharpe and Gabai. Sharpe teaches that the toy figure performs a play pattern. Gabai further enhances this feature by providing a clear teaching that the toy is incorporated in a play pattern procedure- see reference to the toy being represented in a game of the game system of Gabai (Fig. 2A and other citations above).

Further, the examiner has updated the search and cited further prior art that is pertinent to the applicant's disclosure.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3714

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

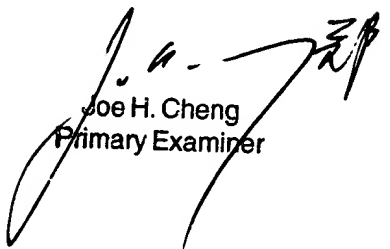
***USPTO Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7768 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.

  
CW

  
Joe H. Cheng  
Primary Examiner